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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,134	06/08/2006	Wolfram Andersch	2400.0470000	9116

26111 7590 01/27/2009  
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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CHUI, MEI PING

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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01/27/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/582,134	ANDERSCH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MEI-PING CHUI	1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/23/2007 and 03/30/2007</u> .                               | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Action***

The Examiner acknowledges receipt of application number 10/582,134 filed on 06/08/2006. Claims 9-10 have been cancelled, and claims 1-8 and 11-13 are presented for examination on the merits for patentability.

For claims 2-8, Applicants are suggested to delete the article "A" at the beginning of each dependent claim and insert the article "The" instead.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-8 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ding et al. (U. S. Patent Application Publication No. 2005/0197251) in view of Uhr et al. (U. S. Patent No. 6,828,275).**

*Applicants Claim*

Applicants claim a composition comprising a synergistically effective mixture of thiodicarb and at least one compound from chloronicotinylns. Applicants also claim a method of controlling animal pests comprising applying the composition to an area to be rid of said pests.

*Determination of the scope and content of the prior art  
(MPEP 2141.01)*

Ding et al. teach a composition comprising one or more of the active ingredients from pesticides, insecticides or nematocides, i.e. chloronicotinylns, nitroguanidine and carbamates. More specifically, Ding et al. teach that suitable and useful chloronicotinyln insecticides, i.e. acetamiprid, imidacloprid or nitenpyram, and suitable nitroguanidine insecticides, i.e. clothianidine, can be used in the composition (page 4: [0040-0041]). In addition, Ding et al. teach that carbamate insecticides, i.e. thiodicarb, are also useful and can be incorporated in the composition (page 5: [0047]). It is noted that thiodicarb is a known insecticide which has the chemical structure as disclosed in instant claim 1.

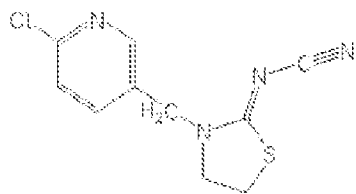
Ding et al. further teach that additional useful ingredient, i.e. surfactant, can provide benefits of permitting control of permeability of the coating, which modulates the release rate of the active through coating (page 3: [0030], lines 1-4).

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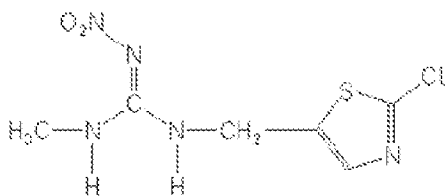
*Ascertainment of the difference between the prior art and the claims*  
(MPEP 2141.02)

(1) Ding et al. do not expressly teach that the insecticide mixtures are for controlling animal pests. However, this deficiency is cured by Uhr et al.

Uhr et al. teach a method for the protection of wood against insecticidal attack comprising the step of applying a synergistically effective amount of a mixture comprising insecticides, i.e. at least one agonist or antagonist of nicotinic acetylcholine receptors as crop protection agents onto said wood (column 16, claim 1 and column 1, lines 10-13). Uhr et al. teach that the insecticidal composition comprising at least one agonist or antagonist of nicotinic acetylcholine receptors exhibit synergistic insecticidal effect when combine with active fipronil and are suitable for protecting materials, i.e. wood, against attack by insects (column 1, lines 31-35 and column 7, lines 46-50). More specifically, Uhr et al. teach that the agonists or antagonists of the nicotinic acetylcholine receptors are the compounds of the formula (I), such as follows:



(known as thiacloprid and see column 5, lines 20-25), or

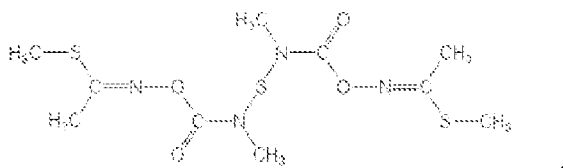


(known as clothianidin and see column 6, lines 35-40).

Uhr et al. also teach that the mixture, which comprises at least one agonist or antagonist of the nicotinic acetylcholine receptors, can also combine with other insecticides in order to achieve additional activity against wood-destroying and wood-discoloring fungi, as well as

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additional synergistic effects or synergisms against attack by insects (column 9, line 64 through column 10, line 2). Examples of additional insecticides that can be admixed include carbamate type of insecticides, i.e. thiodicarb (column 10, lines 13 and 18), which has known chemical structure as follows:



(2) Ding et al. teach insecticides chloronicotinyls, i.e. imidacloprid, acetamiprid, nitenpyra or clothianidin, can be used in combination with thiodicarb. However, Ding et al. do not teach the combination of thiodicarb with other chloronicotinyls, i.e. thiamethoxam, dinotefuran and thiacloprid.

***Finding of prima facie obviousness Rational and Motivation***  
***(MPEP 2142-2143)***

It would have been obvious to a person of ordinary skilled in the art at the time the invention was made to combine the teachings of Ding et al. and Uhr et al. to arrive at the instant invention.

One of ordinary skill would have been motivated to combine insecticides, i.e. a carbamate insecticide (thiodicarb) with at least one agonist or antagonist of the nicotinic acetylcholine receptors, and applies the mixture onto the wood for protecting the wood against insects attack, as taught by Uhr et al. One of ordinary skill also would have been motivated to try other known chloronicotinyls, i.e. thiamethoxam, thiacloprid, dinotefuran, and extend the

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selection of chloronicotinyis in combination with thiodicarb in order to obtain a mixture that can be used to fight against insects attack.

Therefore, it would have been obvious that one of ordinary skill in the art would have had a reasonable expectation of success in producing claimed invention. The invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference.

### ***Conclusion***

No claims are allowed.

### ***Contact Information***

Any inquiry concerning this communication from the Examiner should direct to Helen Mei-Ping Chui whose telephone number is 571-272-9078. The examiner can normally be reached on Monday-Thursday (7:30 am – 5:00 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either PRIVATE PAIR or PUBLIC PAIR. Status information for unpublished applications is available through PRIVATE PAIR only. For more information about

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the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the PRIVATE PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/H. C./

Examiner, Art Unit 1616

/Mina Haghighatian/  
Primary Examiner, Art Unit 1616